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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,860	09/05/2003	Ruiming Zhang	65448 00010	7276

20873 7590 03/17/2006

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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT PAPER NUMBER

1714

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/655,860	Applicant(s) ZHANG ET AL.	
	Examiner Patrick D. Niland	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/03</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 9-12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4787992 Waynick .

Waynick discloses a grease which falls within the scope of the instant claims and which contains base oil falling within the scope of the instant claims 2 and 3 (abstract; column 4, lines 45-52), colorant (column 4, lines 7-10), calcium carbonate which falls within the scope of the instantly claimed polishing agent of claims 1, 9, 10, 11, 12, and 14 (column 11, lines 36-54; column 12, lines 33-68; and column 14, lines 27-28 which encompasses the instantly claimed particle sizes); and overbased sulfonates (column 13, lines 9-29) and column 3, lines 55-63 which encompasses the instantly claimed amounts. See the abstract; column 1, lines 60-68; column 2, lines 1-54; column 3, lines 1-68 of which line 8 discloses its use in bearings; column 9, lines 1-68; and the remainder of the document.

3. Claims 1-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 4787992 Waynick in view of US Pat. No. 4810396 Jao et al., US Pat. No. 5676708 Smith, US Pat. No. 2465961 van Olphen, and US Pat. No. 3021182 Schnacke.

Waynick discloses a grease which falls within the scope of the instant claims and which contains base oil falling within the scope of the instant claims 2 and 3 (abstract; column 4, lines 45-52), colorant (column 4, lines 7-10), calcium carbonate which falls within the scope of the

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instantly claimed polishing agent of claims 1, 9, 10, 11, 12, and 14 (column 11, lines 36-54; column 12, lines 33-68; and column 14, lines 27-28 which encompasses the instantly claimed particle sizes); and overbased sulfonates (column 13, lines 9-29) and column 3, lines 55-63 which encompasses the instantly claimed amounts. See the abstract; column 1, lines 60-68; column 2, lines 1-54; column 3, lines 1-68 of which line 8 discloses its use in bearings; column 9, lines 1-68; and the remainder of the document.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the overbased calcium sulfonates of the instant claims 5-7 and 18 in the compositions of Waynick because Waynick discloses these overbased sulfonates broadly and the benefits of the overbased sulfonates of the instant claims disclosed by Jao would have been expected in the compositions of Waynick. See Jao, example 1 and column 1, lines 12-41.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the calcium carbonate of Waynick as obtained from marble of the instant claim 13 because this is the most available natural form of calcium carbonate.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the dyes and amounts thereof of the instant claims 15-20 and 30 in the compositions of Waynick because Waynick encompasses the use of small amounts of dyes and these dyes are known for use in greases as shown by Smith.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed hexane glycol in the instantly claimed amount in the greases discussed above because van Olphen discloses such glycols for stabilizing lime greases

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and this stability would have been expected in Waynick which discloses using stabilizers at column 4, line 40.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the above composition to clean bearings according to the instant claims 24-30 because Waynick states that their compositions can be used with bearings and Schnacke discloses the general method of the instant claims at column 1, lines 8-54; column 2, lines 1-3; and column 3, lines 1-28. The patentee is silent regarding any run period. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the run period of the instant claims 24-30 because running the bearings while flushing them will clearly give the newly added grease a chance to circulate through the system better and the longer the run, the more adequate circulation of new grease will be.

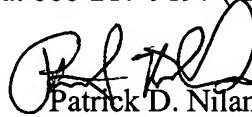
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
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